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APPLICATION NO. 46	FILING DATE 06/95	FIRST NAMED INVENTOR GRASSBERGER	ATTORNEY DOCKET NO. 900-9523/CON
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12M2/0613

EXAMINER
GOLDBERG, J

ART UNIT 1205
PAPER NUMBER

DATE MAILED: 06/13/97

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Group 1200
Paper No. 10
6/13/97

Application Number: 08/471,146

Filing Date: 06/06/95

Appellant(s): MAXIMILIAN GRASSBERGER, ET AL.

ROBERT S. HONOR

For Appellant

EXAMINER'S ANSWER

Art Unit: 1205

This is in response to appellant's brief on appeal filed April 24, 1997.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: the rejection of claims 19 to 26 for obviousness-type double patenting over the claims of U.S. Patent No. 5,366,971 is withdrawn in view of the terminal disclaimer filed April 24, 1997.

The rejection of claims 19-26 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

The copy of the appealed claims contained in the Appendix to the brief is correct.

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

No new prior art has been applied in this examiner's answer.

The following ground(s) of rejection are applicable to the appealed claims:

Claims 19-26 stand rejected under 35 U.S.C. 103 as being unpatentable over the EP 0184,162 patent of record. The patent teaches compositions containing appellants' ^{tricyclo}~~tri~~cyclo

Art Unit: 1205

compounds (see formula I, page 3) with "carrier or excipient suitable for external... application" (page 76, line 13) and is useful for treating lupus erythematosus (page 67, line 3). In view of this, the claimed topical compositions would have been motivated to the skilled artisan. Appellants' remarks are noted but the claims are directed to compositions and not method of use claims. The claims are directed to a lotion which can be ^a or suspension. The suspension is set forth on page 76, line 19. The claimed gel is usually in the form of a solid or semisolid. The solid or semisolid form is set forth on page 76, line 25. The claimed cream is usually in the form of an emulsion. The emulsions is set forth on page 76, line 19. The carrier in the claim is in a generic form and can read on the prior art carrier set forth on page 76. In view of this, appellants' compositions would be motivated.

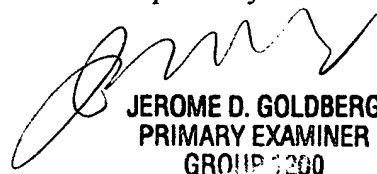
(12) *New Ground of Rejection*

This examiner's answer does not contain any new ground of rejection.

For the above reasons, it is believed that the rejections should be sustained.

Goldberg/sg
JUNE 6, 1997

Respectfully submitted,



JEROME D. GOLDBERG
PRIMARY EXAMINER
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Serial Number: 471146

Art Unit: 1205

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For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



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